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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,082	07/24/2003	David C. Eby	29618/38940	9958
4743	7590	09/27/2005		
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER GREEN, BRIAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,082

Applicant(s)

EBY ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The proposed drawing correction to figure 1 filed on July 11, 2005 has not been approved since the addition of the foldable stand (13) is considered to be new matter. The original specification fails to provide support for the stand (13) as shown in figure 1.

Since the proposed drawing correction filed on July 11, 2005 has not been entered since it contains new matter the drawings still include the following drawing problems.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the easel defined in claims 10-12 and 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because in figure 1 the hole/opening in the lower portion of the flexible sheet (12) should be labeled with a numeral and lead line.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,5,8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Wyant (U.S. Patent No. 3,870,223).

Wyant shows in figures 1-6 a “cascadable file jacket” comprising a flexible substrate (17,21) having first and second surfaces, a file pocket adjacent to the first surface (in figure 1, the first surface is considered to be the surface that can be seen in figure 1) and including a first ply (12) foldably connected to a second ply (13), the first surface being disposed between the second surface (the back surface of the substrate which can not be seen in figure 1) and the first ply, a first tab (26) connected formed integrally to the first ply and adapted to fixedly engage the file pocket to the second surface, and a second tab (28) formed integrally to the second ply and adapted to expandably engage the file pocket to the second surface. In regard to claim 5, the file pocket is “adapted” to accept at least one piece of 8.5 by 11.0 inch paper, i.e. the paper can be folded and placed within the pocket. In regard to claim 8, the particular method used to secure the tabs is not given any patentable weight in an article claim. In regard to claim 9, the second ply is folded at lines (14,29) and the front surface of the ply is considered to include a label portion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4,6,7, and 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant (U.S. Patent No. 3,870,223) in view of Able (U.S. Patent No. 6,349,491).

Wyant discloses the applicant's basic inventive concept except for placing first and second mounting holes in the flexible substrate. Able shows in figure 1 the idea of placing first and second mounting holes in a substrate in order to allow the substrate to be hung. In view of the teachings of Able it would have been obvious to one in the art to modify Wyant by placing first and second holes in the flexible substrate since this would allow the device to be hung up in an easier and more convenient manner for both storage and display purposes. In regard to claims 3,17, and 20, Able shows in figure 1 the idea of placing grommets (40) within the first and second holes. In view of the teachings of Able it would have been obvious to one in the art to modify Wyant by placing grommets within the mounting holes since this would help to prevent the flexible sheet from tearing in the area around the mounting holes. In regard to claims 4,14, and 21, Able shows in figure 1 the idea of placing a third hole (20, the holes on the bottom in fig. 1) on the flexible substrate. In view of the teachings of Able it would have been obvious to one in the art to modify Wyant by placing a third hole on the flexible substrate since this would allow the device to be hung in either a vertical or horizontal orientation. In regard to claims 6 and 18, Wyant does not disclose whether the flexible substrate is formed from polypropylene. Able discloses in column 5, lines 59-64, the idea of making the base 12 and sections 14 out of flexible polypropylene. In view of the teachings of Able it would have been obvious to one in the art to modify Wyant by making the flexible substrate out of polypropylene since this would create a stronger and more durable substrate. In regard to claim 7, Wyant does not disclose whether the

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file pocket is formed from a poly-sheet material. Able discloses in column 5, lines 59-64, the idea of making the base 12 and sections 14 out of flexible polypropylene. In view of the teachings of Able it would have been obvious to one in the art to modify Wyant by making the pocket out of poly-sheet material since this would create a stronger and more durable pocket. In regard to claim 13, Wyant shows in figure 1 that the second ply includes second (28) and third (the tab adjacent the fold line 14, to the right of recess 39 as shown in figure 1) tabs and the third tab is "adapted" to engage the first ply at the line 14. In regard to claim 15, the portion just to the left and right of the line 29 in figure 1 is considered to be part of the second tab and is considered to be the "expandable portion". In regard to claim 16, Wyant shows a label portion (37).

In regard to claim 22, the second ply is folded at lines (14,29) and the front surface of the ply is considered to include a label portion. In regard to claim 23, Wyant shows in figure 1 that the first ply includes a third tab (the tab adjacent the fold line 14, to the left of recess 39 as shown in figure 1) and the third tab is "adapted" to engage the second ply at the line 14. In regard to claim 24, the particular method used to secure the tabs is not given any patentable weight in an article claim.

Claims 10-12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant (U.S. Patent No. 3,870,223) in view of Weber (U.S. Patent No. 759,946).

Wyatt discloses the applicant's basic inventive concept except for having the flexible substrate cooperate with an easel. Weber shows in figures 1-4 the use of a foldable triangular stand (1-5) for supporting a display device. In view of the teachings of Weber it would have been obvious to one in the art to modify Wyant by making the flexible substrate cooperate with

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an easel since this would allow the device to be held in an upright manner for display and storage purposes. In regard to claims 11 and 12, Weber shows that the easel includes at least one inclined leg and is in the form of a triangular stand.

Response to Arguments

Applicant's arguments filed July 11, 2005 have been fully considered but most of the arguments are moot in view of the new grounds of rejection.

The applicant argues that adding the easel in figure 1 is not new matter since the applicant defines the easel in claims 10-12 and 25. The examiner disagrees since original claims 10-12 and 25 fail to provide sufficient support for the size of each portion of the easel, the specific shape of each portion of the easel, the location and size of the hinge lines, and the locations upon which the easel is attached to the substrate.

Allowable Subject Matter

Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 27 is allowed.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg

Sept. 23, 2005